

REMARKS

The Office action mailed October 19, 2006, indicated that claims 1, 10, 18, and 32-34 contain allowable subject matter, rejected claims 1, 14, 29, 30, and 43, and did not appear to consider the remaining claims. The applicant respectfully requests reconsideration of the claims in light of this reply.

I. Failure to consider all claims

Although the Office action summary states that claims 1-56 are rejected and the action itself states that claims 1-56 are pending, the Office action discusses only claims 1, 10, 14, 18, 29, 30, 32-34, and 43. The action does not discuss the remaining claims, including independent claim 31. As such, it appears that these claims were not considered.

The applicant respectfully requests that all claims be considered. Additionally, the applicant notes that any rejections of unconsidered claims would be new rejections and, thus, would preclude making a further action final.

II. Response to claim rejections

Claims 1, 14, 29, 30, and 43 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant respectfully traverses this rejection.

The applicant points out the following text from sections 2173.05(b) and 2173.02 of the M.P.E.P.

Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

Nowhere does the action assert that one of ordinary skill would not have been apprised of the scope of these claims or would not have understood the scope of these claims. The action merely states "[i]t is not clear how the one bit-mismatch between the comprand and the incoming (masked TCAM) **result in** a M-bit mismatch between the encoded CAM word and the encoded comprand. For example, the CAM word could be produced only if the one bit-mismatch satisfy certain conditions to result in a M-bit mismatch."

This statement does not support the assertion that one of ordinary skill would not have been able to determine the scope of these claims. Instead, this statement appears to assert that the claims must include additional details relating to how the incoming CAM is encoded and how the similarly encoded comparand is generated. The second paragraph of section 112 does not include any such requirement relating to the amount of detail required by a claim. Note specifically section 2173.04 of the M.P.E.P., which explains that "[b]readth of a claim is not to be equated with indefiniteness."

When viewed in light of the specification, these claims clearly satisfy the requirements of the second paragraph of section 112. The language and meaning of these claims are understandable to one of ordinary skill in the art, and each of these claims serves the notice function by providing a clear warning to others as to what constitutes infringement of the patent. As such, these claims are patentable under the second paragraph of section 112.

III. Conclusion

In view of this reply, the applicant believes the pending application is in condition for allowance. If there are any formal matters remaining, the applicant respectfully requests the examiner to telephone the undersigned. If there are any additional fees associated with the filing of this reply, including fees required under 35 C.F.R. §§ 1.16 or 1.17, please charge them to deposit account no. 04-1073.

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Respectfully submitted,

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